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Paper No. 10
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re eUniversity, Inc.

Serial No. 75/894,767

Ali Kamarei of INHOUSE IP Counsel for eUniversity, Inc.

Andrea D. Saunders, Trademark Examining Attorney, Law
Office 108 (David Shallant, Managing Attorney).

Before Cissel, Hanak and Quinn, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On January 12, 2000, applicant filed the above-identified application to register the mark "EUNIVERSITY" on the Principal Register for "educational scholarships," in Class 36. The basis for filing the application was applicant's claim that it had used the mark in interstate commerce since November 24, 1998.

In addition to raising issues regarding the recitation of services and the specimens of use, the Examining Attorney refused registration under Section 2(e)(1) Lanham

Act, 15 U.S.C. Section 1052(e)(1), on the ground that the mark is merely descriptive of the services in connection with which applicant seeks to register it.

In support of the refusal to register, the Examining Attorney submitted dictionary definitions of "E-mail" as "electronic mail" and of "university" as "an institution for higher learning..." The Examining Attorney held that the mark immediately describes the characteristics and features of the services because "it refers to an institution of higher learning that is accessed electronically and that awards educational scholarships to students." Also attached to the first Office Action were excerpts retrieved from the Nexis database of publications demonstrating that universities award scholarships.

Applicant responded to the refusal to register with argument that its mark is not merely descriptive of the services set forth in the application, but rather is only suggestive of them. Applicant argued that whereas "UNIVERSITY" is descriptive of its services and "ELECTRONIC UNIVERSITY" is "probably" descriptive of them, "E-UNIVERSITY" "may be descriptive," but "EUNIVERSITY" is only "merely suggestive" of the services. Applicant took the position that compressing the term "E-UNIVERSITY" by removing the hyphen creates a mark which "requires a

certain amount of creative imagination to comprehend the specific attributes of the online services provided."

Applicant went on to argue that its mark is not merely descriptive "because the consumer's mind must stretch to imagine an online university experience."

Applicant amended the recitation of services to read as follows: "providing educational scholarships," in Class 36. Additional specimens of use were also submitted responsive to the first Office Action.

With her second Office Action, the Examining Attorney made final the refusal to register under Section 2(e)(1) of the Act, maintaining that the mark describes a feature or characteristic of the services, namely that the scholarships provided under the mark are for studies at an electronic university, and/or that the service of providing the educational scholarships is provided electronically. Submitted in further support of the refusal were additional excerpts, retrieved from the Nexis database, wherein "e-University" is used synonymously with "electronic university" in connection with providing educational services by means of the Internet. All but one of these excerpts, however, are attributed to either wire services or publications identified as having their origins outside the United States, so they are not evidence that the public

in this country has been exposed to the uses of the terms therein. The sole example from this country is an excerpt from the August 27, 1998 edition of the Milwaukee Journal Sentinel wherein an individual appears to be identified as the recipient of an "e University National Merit Scholarship."

In addition to making final the refusal to register based on descriptiveness, the Examining Attorney refused to accept the substitute specimen applicant had submitted in response to the requirement which had been made in the first Office Action.

Applicant responded by filing a Notice of Appeal and by submitting another specimen of use of the mark, arguing that this one did show the mark used in connection with the services identified in the application. The specimen is a printout of a computer screen wherein applicant promotes its educational services and notes that it "can arrange for corporations to provide educational scholarships for their employees."

The Board instituted the appeal, but suspended action on it and remanded the application to the Examining Attorney for consideration of the acceptability of the substitute specimen submitted by applicant. The Examining

Attorney accepted the specimen, but maintained the refusal to register based on descriptiveness.

Applicant timely filed an appeal brief and the Examining Attorney responded with her brief on appeal. Attached to the Examining Attorney's brief were copies of entries from The Computer Glossary, a dictionary of which we can take judicial notice, wherein "e-" is listed as "(Electronic-) The 'e-dash' prefix may be attached to anything that has moved from paper to its electronic alternative, such as e-mail, e-cash, etc." The same page of this dictionary provides definitions of "e-business" as "doing business online," and of "e-card" as "a digital greeting card or postcard created on the Web." Also attached to the brief of the Examining Attorney were two entries from AF Acronym Finder, an on-line database of acronyms, abbreviations and initialisms. "E" was listed there as an acronym for "Electronic."

Applicant did not request an oral hearing before the Board, so we have resolved this appeal based on consideration of the written record in the application and the arguments presented in the appeal briefs.

It is well settled that a term is considered to be merely descriptive of services within the meaning of Section 2(e)(1) of the Trademark Act if it immediately and

forthwith conveys information with regard to a characteristic or feature of the services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the services in order for it to be considered merely descriptive of them; rather, it is sufficient if the term describes a single significant attribute or feature. Moreover, whether a term is merely descriptive is determined not in the abstract, but in relation to the services for which registration is sought, the context in which it is being used in connection with those services, and the possible significance that the term would have to the average purchaser of the services because of the manner of its use. In re Bright-Crest, 204 USPQ 591 (TTAB 1979). Accordingly, whether a prospective purchaser could correctly speculate as to what the services are from consideration of the mark alone is not the test. In re American Greetings Corp., 226 USPQ 365 (TTAB 1985).

The case at hand is analogous to the situation presented in In re Styleclick.com Inc., 57 USPQ2d 1445 (TTAB 2000). In that case, we held that the proposed mark "E Fashion" was merely descriptive of "computer software for consumer use in shopping via a global computer network and computer software for providing fashion, beauty and

shopping advice," in Class 9, and "electronic retailing services via a global computer network featuring apparel, fashion, accessories, personal care items, jewelry and cosmetics," in Class 35. We noted (at p. 1448) that "in the year 2000" the "e-" prefix "has the generally recognized meaning of 'electronic' in terms of computers and the Internet." We found that "[w]hen this non-source-identifying prefix" was coupled with the descriptive word "Fashion," the mark, as a whole, merely described applicant's goods and services. Citing *In re Central Sprinkler Co.*, 49 USPQ2d 1194 (TTAB 1998), we further commented that this conclusion was not affected by the fact that the applicant may have been the first or only entity using the term it sought to register.

Applying the same reasoning to the closely analogous facts presented by the case at hand, we must conclude that the mark here sought to be registered, "EUNIVERSITY," is merely descriptive of the service of providing scholarships to applicant's on-line university. Providing educational scholarships is a service which prospective students would expect to be provided by a university. Such people would immediately, without the need for complex reasoning or multi-stage thought processes, understand the use of the prefix "E" with the descriptive term "UNIVERSITY" to be an

indication that these services are being provided by an electronic university, that is, an institution providing its educational services on-line, by means of the Internet.

Applicant's arguments to the contrary are not persuasive of a different result. The materials submitted by the Examining Attorney show that neither the use of the upper-case letter "E" nor the absence of the hyphen change the readily-understood meaning likely to be attributed to the term applicant seeks to register.

On p. 2 of its brief, applicant argues that its mark is registrable because the mark is "Euniversity [sic], NOT Eschoalrships [sic]," but the term with which the descriptive prefix "E" is combined does not have to be generic for the services. In order for a refusal based on Section 2(e)(1) to be justified, it is sufficient if the term is merely descriptive of the services. The word "university," as noted above, is merely descriptive in connection with providing educational scholarships because, as the record shows, universities provide such services, and the scholarships are to universities. It is a significant feature or characteristic of these services that the scholarships provided are by or for a university. The letter "E," as the evidence demonstrates, is an indication that the services are rendered electronically.

As the Examining Attorney points out, in the context of the services applicant renders under the mark, there is nothing in the term "EUNIVERSITY" that is ambiguous, incongruous or susceptible to any other plausible meaning. This mark is merely descriptive of the fact that applicant provides educational scholarships electronically, by means of the Internet. As noted above, it also describes the fact that the scholarships provided are for studies at an electronic university, so the mark is merely descriptive under Section 2(e)(1) of the Lanham Act.

Accordingly, the refusal to register must be affirmed.